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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,449	12/27/2005	Eiji Shiba	055053-0105	3547
23428 7590 10/27/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
ZEMEL, IRINA SOPHIA				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
10/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/562,449

**Applicant(s)**

SHIBA ET AL.

**Examiner**

Irina S. Zemel

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 8-20-2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of WO 02/14423 to Kuraray Co., (hereinafter "Kuraray") or JP 001-26663 to Sanwa Kako KK., (hereinafter "Sanwa") in combination with EP 1229076 to Mitsui Chemicals, INC., (hereinafter "Mitsui").

The disclosure of Kuraray and Sanwa are discussed in detail with respect to the limitations of all pending claims in the previous office action. The disclosure of Mitsui is also disclosed with respect to the limitations of claim 8.

The claims are currently amended to positively recite the presence of ethylene/polar monomer copolymer (A2) in the claimed compositions. Addition of this components, such as EVA copolymers, to compositions of either Sanwa or Kuraray would have been obvious from the disclosure of Mitsui, which disclosure expressly teaches that addition of EVA copolymers to ethylene based foaming composition in the amounts corresponding to the claimed amounts results in improved tear strength of the forams, see, for example, [0047-50] and examples of Mitsui.

### ***Response to Arguments***

Applicant's arguments filed 7-20-2009 have been fully considered but they are not persuasive. It is noted that no new arguments were filed with RCE on 8-20-2009. The arguments filed with the after final response dated 7-20-2009 were

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considered in the advisory action to the extent that the arguments were pertinent to the claimed pending in the application at that time. Specifically, the arguments regarding Kuraray disclosing crosslinked composition are not convincing, since the reference clearly discloses that composition first are obtained by melt mixing at the temperatures below the decomposition temperatures of either crosslinking agent or blowing agent. See, for illustrative example where mixing is done at about 121 C, which is significantly below the decomposition temperature of dicumylperoxide and azodicarbonamide. Thus, the disclosed composition prior to sheeting is un-crosslinked. Regarding the arguments that the office fails to provide motivation to substitute SIS block copolymer with SBS in the invention of Sanwa, the examiner provided express motivation for such substitution (which is quoted by the applicants). Simply because such substitution provides results that may be inferior for one application does not mean that one of ordinary skill in the art will not be able to recognize the obvious advantages for another applications and make such an obvious substitution .

The arguments regarding the compositions of Kuraray or Sanwa not containing the third component, i.e. ethylene/polar monomer component, this arguments are moot in view of the new grounds of rejection as discussed above in the body of the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1796

Irina S. Zemel  
Primary Examiner  
Art Unit 1796

ISZ